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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/806,455	03/30/2001	Erik Adolfsson	4013-0158P	1414

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EXAMINER

DERRINGTON, JAMES H

ART UNIT	PAPER NUMBER
1731	6

DATE MAILED: 09/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/806,455	ADOLFSSON ET AL.	
Examiner	Art Unit		
James Derrington	1731		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-12 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> . | 6) <input type="checkbox"/> Other: _____. |

Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are somewhat narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and have some grammatical and idiomatic errors. Clarification is requested. In claims 1 and 12, the recitation "for decomposition (e.g. vaporization)" is vague and indefinite (emphasis added). Additionally the scope of the recitation (claim 10) "helping agent ... in order to further suppress unwanted reactions, like decomposition and oxidation" (emphasis added) is indefinite. The recitation scope of the phrase "easily decomposing hydrate" as recited in claim 11 is unclear.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74

(Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

In the present instance, claims 3-7 recite a broad range, a preferably range and an even more preferred range. Correction is requested.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 5-7 and 12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hermansson et al (5,306,673).

This reference discloses the process of encasing a bioactive composite material in glass (Col. 4, lines 4-22) and hot isostatically pressing. The composite material comprises apatite and a ceramic such as alumina, zirconia or titania in the claimed amounts. Because the temperatures and pressures of Hermansson et al are substantially the same of those recited in the claims and shown in the specification (Compare examples at Col. 4 of the reference with temperatures disclosed in the instant examples and dependent claim 7), the reference appears to meet the limitation "before

commencing substantial decomposition of apatite phase". With regard to claim 6, it is reasonable to conclude that the composite materials of Hermansson et al are enclosed in the glass at low temperatures, e.g. room temperature, prior to using the hot isostatic pressure and temperature.

Claims 1, 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heide et al (4,309,488).

Heide et al discloses the process of encasing a bioactive composite material in a mold (Col. 5, line 59 ff) and hot isostatically pressing. The composite material can comprise calcium phosphate and metal, e.g. titanium (Col. 6, line 7). Heide et al disclose that the calcium phosphate and metal can be formed as a composite depicted in Fig. 3 and discussed at Col. 4, lines 38-46). It is reasonable to conclude that Heide et al would not have used pressure and temperature conditions that cause substantial decomposition of the apatite phase.

Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hermansson et al (5,306,673) or Heide et al (4,309,488) in view of Sugimura et al (5,096,450).

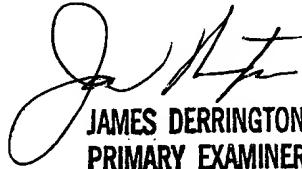
Hermansson et al and Heide et al have been discussed above. Sugimura et al also disclose a hot isostatic process for preparing composites of metal powder and metal oxides (Col. 3, lines 5-35) following a heating and pressure schedule depicted in Fig. 5. The pressure is increased over time and two different temperatures are used. It would have been obvious to use a temperature and pressure increasing schedule with the processes of the primary references for art recognized purposes.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Derrington whose telephone number is 703 308-3832. The examiner can normally be reached on 8:30am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 703 308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are 703 305-7718 for regular communications and 703 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0661.

jd
September 17, 2002


JAMES DERRINGTON
PRIMARY EXAMINER
ART UNIT 137 / 1731